

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Brian Aegerter, et al.

Application No.: 10/647,914

Conf. No.: 2441

Filed On: August 26, 2003

For: SELECTIVE TREATMENT OF MICROELECTRONIC
WORKPIECE SURFACES

Art Unit: 1746

Examiner: Michail Kornakov

Docket No.: 114183-20 (P00-0024US3)

TRANSMITTAL

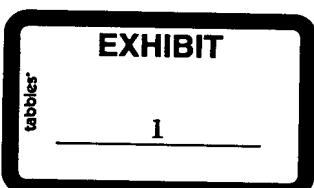
Mail Stop Amendment
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir/Madam:

In response to the final office action dated October 13, 2006, enclosed
please find the following:

Response To Final Office Action Dated October 13, 2006;

Request To Add An Inventor Under 37 C.F.R. § 1.48 And Petition
Under § 1.47(a);



Application No. 10/6414
Transmittal
January 8, 2007

Declaration Under 37 C.F.R. §§ 1.48 and 1.131 of Steven L. Peace;
Replacement Declaration And Power Of Attorney; and
Consent By Assignee Under 37 C.F.R. § 1.48(c).

Applicants have enclosed the fees they believe are necessary for filing the above documents; however, the Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment, to Deposit Account No. 50-3891. A duplicate copy of this sheet is enclosed.

Respectfully submitted,


Keith V. Rockey
Registration No. 24,713

Rockey, Depke, Lyons & Kitzinger, LLC
Sears Tower, Suite 5450
233 South Wacker Drive
Chicago, Illinois 60606

January 8, 2007

CERTIFICATE OF MAILING (37 C.F.R. § 1.10)

I hereby certify that this correspondence and/or fee is, on the date shown below, being deposited with the United States Postal Services as Express Mail Post Office to Addressee, No. EV 871552539 US, with sufficient postage, January 8, 2007.


Eileen Madrigal

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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RESPONSE TO FINAL
OFFICE ACTION DATED OCTOBER 13, 2006

Mail Stop Amendment
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir/Madam:

In response to the Final Office Action dated October 13, 2006, there are no amendments to the specification or claims.

REMARKS/ARGUMENTS begin on page 2 of this paper.

REMARKS/ARGUMENTS

In the amendment previously submitted in this application, applicants indicated an intent to submit a declaration under 37 C.F.R. § 1.131 to demonstrate that the prior art cited against the present application is not prior art on the ground that the subject matter of the present claims were conceived and reduced to practice prior to the earliest filing date available to U.S. Patent No. 6,290,865 patent (“the ‘865 patent”). Submitted herewith are the papers demonstrating that Steven L. Peace, a Semitool engineer, conceived and reduced to practice the subject matter of the claims in this application before the earliest date available to the ‘865 patent, namely November 30, 1998.

Applicants also submit a request under 37 C.F.R. § 1.48 to add Mr. Peace as an inventor and a petition under 37 C.F.R. § 1.47(a). As the Peace declaration demonstrates, he was omitted without deceptive intent by reason of a change in the claims in the application.

Under these circumstances, the Examiner should determine that Mr. Peace is a co-inventor along with the named inventors. The Examiner should also accept Mr. Peace’s declaration demonstrating prior conception and reduction to practice of the subject matter of these claims. That removes the ‘865 patent as prior art and thus the present application should be deemed allowable and an interference with the ‘865 patent declared. Such action is respectfully solicited.

Application No. 10/647,14

Response to Final

Office Action Dated October 13, 2006

January 8, 2007

Respectfully submitted,



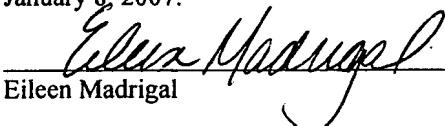
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Art Unit: 1746

Examiner: Michail Kornakov

Docket No.: 114183-20 (P00-0024US3)

REQUEST TO ADD AN INVENTOR UNDER
37 C.F.R. § 1.48 AND PETITION UNDER § 1.47(a)

NOW COME applicants in the above-identified application and hereby request, under the provisions of 37 C.F.R. § 1.48, to add as an inventor in this application Steven L. Peace. The fee of \$130 accompanies this request. Applicants also petition, under the provisions of 37 C.F.R. § 1.47, for leave to file the present application without the signatures of Michael Jolley and Curt D. Dundas, both of whom have refused to sign the replacement Declaration and Power of Attorney in the application. The fee of \$200 for this petition is also enclosed.

The present application was filed for the purpose of presenting claims copied from U.S. Patent No. 6,290,865 ("the '865 patent") to provoke an

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interference. During the prosecution of the application, it was discovered that Steven L. Peace, a research engineer employed by Semitool, Inc., the assignee of the present application, had worked with Gary L. Curtis, one of the named inventors, on a number of projects. One such project related to the selected etching of wafers in which an inert fluid is contacted with the wafer on one side while an etchant (e.g., HF or HNO₃) is contacted with the wafer on the other side to remove a metal material. Thus, the inert fluid serves to protect one side of the wafer while the etchant removes whatever surface may be present on the other side of the wafer.

Submitted herewith is a declaration of Mr. Peace under the provisions of 37 C.F.R. §§ 1.48 and 1.131. Mr. Peace points out in his declaration that he conceived and reduced to practice subject matter of claims now in this application, namely the claims that have been copied from the '865 patent. Claims of that scope were not in the application as originally filed and hence Mr. Peace had not been included as a co-inventor. Now that claims specifically directed to that work have been added during the prosecution of the present application, applicants request that Mr. Peace be added as a co-inventor.

In his declaration, Mr. Peace points out that he verily believes that he is a co-inventor of the subject matter now claimed in the application and that Semitool failed to include him as a co-inventor because the subject matter which was the focus of the claims had not been included originally. Quite the contrary, the occasion to add Mr. Peace as an inventor arises from the change in the claims in the application. Accordingly, as Mr. Peace indicates and is self-evident in the

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record in this application, the omission of Mr. Peace as a co-inventor occurred entirely without deceptive intent.

Counsel for Semitool then began, in September of 2006, to prepare the papers to add Mr. Peace as a co-inventor. Since a number of the named inventors were no longer employed by Semitool, counsel for Semitool needed to secure the agreement of the co-inventors to the addition of Mr. Peace as a co-inventor. For example, counsel for Semitool, on September 12, 2006, dispatched a letter by Federal Express to Mr. Michael Jolley explaining the situation (Exhibit A). Mr. Jolley responded to the letter via e-mail (Exhibit B) and commented that the exhibit to Mr. Peace's declaration under 37 C.F.R. § 1.131 lacked a date, and Mr. Jolley questioned why. Mr. Jolley also indicated a preference that his name be deleted entirely from the papers on the ground that he had not played a "significant" role in the invention.

Counsel for Semitool responded to Mr. Jolley's questions via e-mail (Exhibit C), clarifying the date question and pointing out that the application in its present form includes subject matter that Mr. Jolley unmistakably contributed to. Counsel suggested leaving the inventorship issue as it was. Mr. Jolley never responded, and hence has refused to execute the replacement declaration transmitted to him originally.

At the time counsel was preparing the papers to add Mr. Peace as a co-inventor, it was counsel's belief that Mr. Dundas, another named co-inventor, was still employed by Semitool. See, for example, Exhibit D. Only after counsel was unable to secure the signature of Mr. Dundas did he learn that Mr. Dundas no longer worked at Semitool (Exhibit E). Counsel accordingly sent by Federal

Application No. 10/647,714

Request To Add An Inventor Under 37 C.F.R. § 1.48

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Express a similar set of papers (Exhibit F) to Mr. Dundas at his address in Albuquerque, New Mexico, his last address known to Semitool. That letter was sent in November of 2006. Neither counsel nor Semitool has received any response to the requests contained in Exhibit F. Therefore, Semitool believes that Mr. Dundas, despite Semitool's diligent efforts to secure his signature, has refused to sign the renewed declaration in the above application.

Under all these circumstances, applicants submit that they have proceeded diligently in correcting the inventorship in the application and attempting to secure the signatures of both Mr. Jolley and Mr. Dundas. Therefore, the Honorable Commissioner of Patents and Trademarks should accept the present application without the signatures of Messrs. Jolley and Dundas and should add Mr. Peace as a co-inventor.



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One of the Attorneys of Record

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January 8, 2007

Application No. 10/647,714

Request To Add An Inventor Under 37 C.F.R. § 1.48

January 8, 2007

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